

REMARKS

Claims 1-17 are pending in the application. Claims 1-6 and 8-16 have been amended to better describe the invention and for consistency reasons. Favorable reconsideration in light of the amendments and the remarks which follow is respectfully requested.

The Amendments

Independent claim 7 has been amended to disclaim the compositions of the cited art by requiring a pharmaceutical composition consisting of only uridine-5'-monophosphate or cytidine-5'-monophosphate as pharmaceutically active ingredients. The remaining amended claims have been amended without changing the scope thereof to comply with U.S. patent practice.

The §101/§112 Rejection

Claims 1-6 and 10-16 have been rejected under 35 USC §101 and §112 for indefiniteness and lacking patentable subject matter for not positively reciting the acts of the method of use. Claims 1-6 and 10-16 have been amended, without narrowing the scope thereof, to more clearly define the method and to conform with U.S. patent practice. Withdrawal of the rejections is therefore respectfully requested.

The §112, second paragraph Rejection

Claims 5, 8, and 12-16 have been rejected under 35 USC §112, second paragraph, for the phrases including the words "preferably". Claims 5, 8, and 12-16 have been amended, without narrowing the scope thereof, to delete additional recitations of ranges and to conform with U.S. patent practice. Withdrawal of the rejections is therefore respectfully requested.

The Novelty Rejection

Claims 7-9 and 17 have been rejected under 35 USC §102 over the Navarro article. The Examiner contends that Navarro discloses uridine-5'-monophosphate and cytidine-5'-monophosphate (see page 69, 1st full paragraph). More specifically, Navarro describes infant formula containing not only 5.13 mg/l of uridine-5'-monophosphate and 1.68 mg/l of cytidine-5'-monophosphate, but also 2.23 mg/l of guanosine-5'-monophosphate, 1.98 mg/l of adenosine-5'-monophosphate, and 0.68 mg/l of inosine-5'-monophosphate.

To establish anticipation, each and every claim feature must be disclosed in a single cited art document. Independent claim 7 requires a pharmaceutical composition CONSISTING OF uridine-5'-monophosphate or cytidine-5'-monophosphate as pharmaceutically active ingredient optionally together with physiologically acceptable carriers, adjuvants and/or diluents. Navarro fails to disclose, teach, or suggest a pharmaceutical composition consisting of uridine-5'-monophosphate or cytidine-5'-monophosphate as pharmaceutically active ingredient. The function of the "consisting of" transitional phrase is to EXCLUDE the formula of Navarro from the scope of claim 7 due to the presence of additional nucleotides.

This is because, as noted by MPEP § 2111.03, the transitional phrase "consisting of" excludes any element or ingredient not specified in the claim. *In re Gray*, 53 F.2d 520, 11 USPQ 255 (CCPA 1931). MPEP § 2111.03 further notes *Ex parte Davis*, 80 USPQ 448, 450 (Bd. App. 1948) which clearly explains that "consisting of" functions to close the claim to the inclusion of materials other than those recited except for impurities ordinarily associated therewith. Guanosine-5'-monophosphate, adenosine-5'-monophosphate, and inosine-5'-monophosphate, necessary components of Navarro, are not impurities ordinarily associated with uridine-5'-monophosphate or cytidine-5'-monophosphate. Since Navarro fails to disclose each and every element of claim 7, Navarro cannot anticipate claims 7-9 and 17.

Furthermore, one skilled in the art would not consider guanosine-5'-monophosphate, adenosine-5'-monophosphate, and inosine-5'-monophosphate

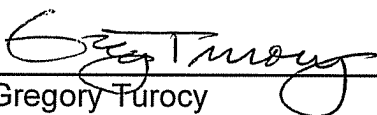
(additional nucleotides of Navarro) as a physiologically acceptable carrier, adjuvant and/or diluent.

Should the Examiner believe that a telephone interview would be helpful to expedite favorable prosecution, the Examiner is invited to contact Applicants' undersigned attorney at the telephone number listed below.

In the event any fees are due in connection with the filing of this document, the Commissioner is authorized to charge those fees to our Deposit Account No. 50-1063.

Respectfully submitted,

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